



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,537	12/13/2001	Gerhard J Bleys	P 282804/EUR	8094

7590

08/26/2003

Pillsbury Winthrop LLP
1600 Tysons Boulevard
McLean, VA 22102

EXAMINER

SERGEANT, RABON A

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,537

Applicant(s)

BLEYS ET AL.

Examiner

Rabon Sergent

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 13, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1,7,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1711

1. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claim 1, applicants have failed to specify the basis for the oxyethylene percent content of the polyether polyol.

Within claim 1, the use of "if used" within step 5 is confusing. It is assumed that the language indicates that water is an optional component.

Within claim 5, "diphenylmethane" has been misspelled.

Within claim 5, applicants have claimed that the polyisocyanate is used in an excessive amount; however, it is unclear what this excessive amount is relative to.

Within claim 5, it is unclear how the 65% by weight limitation relates to "a variant thereof".

Within claim 5, applicants have stated that the ingredients comprise a prepolymer and water; however, within claim 1, applicants have stated that at least 25% by weight of the ingredients consist of a polyether polyol. Therefore, it is unclear if the polyether polyol is a stand alone component of claim 5 or if the polyol was used to produce the prepolymer of claim 5. If the latter situation is the case, then claim 5 is ambiguous and not limited in accordance with claim 1, because the claim no longer requires the stand alone polyether polyol component of claim 1 to be an ingredient.

Art Unit: 1711

Within claim 13, it is unclear how to interpret what constitutes an “apparent overall” density. It is unclear how “apparent” is to modify the language.

2. Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants have failed to define the term, “apparent overall density”. It cannot be determined how the terminology differs from “density” as understood within the art.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

Art Unit: 1711

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Bleys et al. ('779) or Eling et al. ('483).

Patentees disclose resilient flexible polyurethane foams, having densities that meet those claimed by applicants, prepared from the reaction of water, polyisocyanates, and polyether polyols having greater than 50% by weight oxyethylene groups. See abstracts and tables. In view of the disclosures pertaining to the reactant compositions, the position is taken that applicants' claimed ratio of oxyalkylene groups and content of oxyethylene groups is inherently met by the disclosed polyurethanes. Furthermore, in view of the fact that the respective flexible polyurethanes are produced from equivalent reactants and possess overlapping densities, the position is further taken that applicants' claimed vibration transmissibility, resonance frequency, and hardness properties are inherent characteristics of the disclosed polyurethanes.

5. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bleys ('226) or Bleys et al. ('779) or Eling et al. ('483), each in view of Mackey ('409) or ('553) or ('528).

Bleys and Bleys et al. and Eling et al. disclose the production of resilient flexible polyurethane foams prepared from the reaction of water, 4,4'-diphenylmethane diisocyanate, and polyether polyols, having greater than 50% by weight oxyethylene groups, functionalities of 2-6,

Art Unit: 1711

and equivalent weights that overlap those claimed by applicants. See abstracts. Furthermore, patentees disclose that prepolymer processes may be employed and that the polyurethanes may be molded. See column 3, lines 53+ within Bleys. See abstract and column 5, line 13 within Bleys et al. See abstract and column 4, lines 61+ within Eling et al.

6. Though the primary references are silent regarding applicants' claimed process of coating the mold with an external release agent and producing at least 10 moldings prior to recoating the mold with the external release agent, the position is taken that the initial coating of a mold with an external release agent and the subsequent production of up to 40 polyurethane moldings prior to recoating the mold with an external release agent was known at the time of invention. Mackey disclose such molding operations at column 9, lines 52+. Furthermore, it is noted that applicants' claims fail to exclude the use of internal mold release agents. Therefore, it would have been obvious to utilize the molding process of Mackey to produce the polyurethane moldings of the primary references, because one would have been motivated to utilize an efficient and rapid molding process in the production of the polyurethanes, so as to increase throughput and decrease operating expenses. Additionally, it would have been well within the purview of the skilled artisan to treat the mold with release agent at time intervals that provided the greatest efficiency.


7. The USPTO is participating in a search exchange pilot program with the European Patent Office (EPO). As part of the pilot program, the USPTO has received a copy of the Search Report prepared by the EPO on the counterpart EP application for which priority under 35 U.S.C. 119(a)

Art Unit: 1711

is claimed. The references cited in the EPO Search Report have been considered by the examiner and have been listed on the PTO-1449 form. A copy of these references is not being furnished to applicant with this Office action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent
August 25, 2003


RABON SERGENT
PRIMARY EXAMINER